<u>REMARKS/ARGUMENTS</u>

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-2, 4-5, 12-13 and 18 are pending in the present application. Claims 1-2, 4-5, 12-13 and 18 are amended; and Claims 6-11 and 15-17 are canceled without prejudice or disclaimer by the present amendment. Support for the amended claims can be found in the original specification, claims and drawings.[1] No new matter is presented.

As an initial matter, Applicant respectfully requests that the reference included in the Information Disclosure Statement (IDS) filed December 2, 2009, be considered by the Examiner. The reference in the IDS is discussed in an English language translation of a Japanese Office Action submitted with the IDS. Thus, in accordance with MPEP § 609.04(a)(iii), an English language foreign Office Action/Search Report satisfies the requirement for concise explanation of the relevance of the foreign language references, as required under 37 C.F.R. § 1.98. Specifically, the above cited portion of the MPEP states that "where the information listed is not in the English language, but was cited in a Search Report or other action by a Foreign Patent Office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the Search Report or action which indicates the degree of relevance found by the foreign office."

In the Office Action, the specification is objected to because of a minor informality; Claims 1-2 and 6-7 are rejected under 35 U.S.C. § 112, second paragraph; Claims 1 and 6 are rejected under 35 U.S.C. § 101; Claim 18 is rejected under 35 U.S.C. 102(e) as anticipated by <u>Simonoff</u> (U.S. 7,043,529); Claims 1, 4-6, 8-9, 12 and 15 are rejected under 35 U.S.C. § 103(a) as unpatentable over <u>Simonoff</u> in view of <u>Morris et al.</u> (U.S. 2002/0052919, herein

[1] e.g., Figs. 1 and 6-7; pp. 13-14; and pp. 19-21.

Morris); and Claims 2, 7, 10-11, 13 and 16-17 are rejected under 35 U.S.C. § 103(a) as

unpatentable over Simonoff in view of Morris and one of Johnson et al. (U.S. 7,143,177,

herein Johnson) and Erdelyi (U.S. 2004/0056879).

The Office Action objects to the specification for failing to provide antecedent basis

for the term "processor" recited in Claim 18, but does note that the specification refers to a

"CPU". In response, Claim 18 is amended to recite "CPU" instead of "processor". Support

for this amendment can be found at least at Fig. 2 and its corresponding description in the

originally filed disclosure.

Accordingly, Applicant respectfully requests that the objection to the specification be

withdrawn.

The Office Action rejects Claims 1-2 under 35 U.S.C. § 112, second paragraph,

noting that the various "means for" limitations invoke interpretation under 35 U.S.C. § 112,

sixth paragraph, but asserting that the written description fails to link the specific hardware in

the specification to the corresponding structure in the specification. The Office Action also

rejects Claim 1 under 35 U.S.C. § 101, asserting that the "means for" could be "considered as

program per se".

Applicant respectfully traverses the above noted assertions, and submits that the link

between the "means for" limitations recited in Claim 1 and the corresponding components of

the shared server 2, which correspond to these limitations, are clear to one of ordinary skill in

the art based on at least at Fig. 2, pp. 11-12 and p. 28 of the originally filed disclosure.

For example, the "means for storing" corresponds to one or a combination of the

random access memory (RAM) 25 shown in Fig. 2, which is described at p. 11 of the

specification as storing "a program to be executed by the CPU 24, data necessary for

processing and so forth"; the hard disk (HD) 30 shown in Fig. 2, which is described at p. 12

of the specification as storing "for example, the OS, the chat client program and so forth";

and/or the music database 11 shown in Fig. 2, which is described at p. 11 of the specification as having "a plurality of music data stored therein so that it may function as a jukebox server." The "receiving means", "acquiring means" and "transmitting means" correspond to the communication interface 21, CPU 24, and any programs that are read from the read only memory (ROM) 23, RAM 25 and/or HD 25 and processed by the CPU 24 to control the communication interface 21. As disclosed in Fig. 2 and p. 11 of the originally filed disclosure, the "communication interface 21 is an apparatus for connection, for example, to the network 1", and the "CPU 24 executes various application programs and a program of a basic OS ... to perform such various processes as hereinafter described".

Therefore, each of the corresponding components of the sharing server 2 are clearly disclosed and identifiable to one of ordinary skill in the art. Moreover, Applicant respectfully submits that none of these "means for" limitations could reasonably be construed as merely "software per se", as asserted by the outstanding Office Action.

In this regard, Applicant notes that p. 28 of the specification discloses that "the series of processes may ... be executed by software ... a program which constructs the software is installed from a program storage medium into a computer (CPU 24 of Fig. 2 ... incorporated in hardware for exclusive use or, for example, a personal computer ..." (emphasis added). Therefore, if software is implicated in the processes recited in Claim 1, this software is implemented by hardware such as CPU 24, as discussed above.

Applicant further notes *WMS Gaming, Inc. v. International Game Technology*, 184 F.3d 1339 (Fed. Cir. 1999), where the Federal Circuit held that the time domain processing means is a microprocessor programmed to carry out the algorithm. In *WMS Gamming*, the Federal Circuit noted the statutory requirement to focus on corresponding structure.

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Thus, to the extent that the Office is taking the position that the inclusion of a software element in an otherwise statutory apparatus claim somehow takes the claims outside the realm of statutory subject matter, the Office is reminded that:

> Computer programs are often recited as part of a claim. USPTO personnel should determine whether the computer program is being claimed **as part of an otherwise statutory manufacture or machine**. In such a case, the claim **remains statutory irrespective of the fact that a computer program is included in the claim.**[2] (emphasis added)

Further, with regard to Claim 1, a proper analysis under 35 U.S.C. §112, sixth paragraph, requires consideration of the structure corresponding to each "means" recited in the claim. 35 U.S.C. §112, sixth paragraph, states that claim limitation expressed in means-plus-function language "shall be construed to cover the corresponding structure...described in the specification and equivalents thereof." Thus, the claimed "means" includes the appropriate *structure* disclosed in the specification.

Therefore, for at least the reasons discussed above, Applicant respectfully submits that each of the "means for" components recited in Claim 1 clearly correspond to a particular hardware component disclosed, for example, at Fig. 2 and pp. 11-12 of the specification. Moreover, as noted above, the "means for" limitations recited in Claim 1 can not reasonably be interpreted as software only without the inclusion of any hardware components.

Accordingly, Applicant respectfully requests that the rejection of Claims 1-2 under 35 U.S.C. § 112, second paragraph, and under 35 U.S.C. § 101, be withdrawn.

The Office Action rejects Claim 18 under 35 U.S.C. 102(e) as anticipated by Simonoff. In response to this rejection, Applicant respectfully submits that amended independent Claim 18 recites novel features clearly not disclosed by Simonoff

Independent Claim 18, for example, recites, in part, a service providing apparatus for

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[2] *See* Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, USPTO 2005 (Annex IV, Computer Related Non-Statutory Subject Matter) page 53

providing a service to a plurality of information processing apparatuses via a network, said

service providing apparatus comprising:

> a network interface configured:
> ... to receive a content request transmitted from *one* of the plurality of
> information processing apparatuses currently in the chat room;
> ... to acquire the requested content in response to reception of a content
> request; and
> .... to transmit, when the network interface receives the content request
> from the *one* of the plurality of information processing apparatuses currently
> in the chat room, the acquired content to *all of the other* plurality of
> information processing apparatuses currently in the chat room *without*
> *receiving a request for the content from any of the other plurality of*
> *information processing apparatuses currently in the chat room*.

Independent Claims 1, 4-5 and 12, while directed to alternative embodiments, recite

similar features as those emphasized above.

As disclosed in an exemplary embodiment at Figs. 6-7; pp. 13-14; and pp. 19-21 of

the originally filed disclosure, three client computers 3-1, 3-2 and 3-3 may be logged into the

chat room via shared server 2. When only one of the client computers (e.g., 3-1) requests

specific content (e.g. a specific song), the content is transmitted to, and reproduced by, the

other client computers (e.g., 3-2 and 3-3) "even if the other client computers 3-2 and 3-3 do

not request for the music data separately."

In rebutting the previously presented arguments directed to transmitting the acquired

content to "all of the plurality of information processing apparatuses currently in the chat

room", p. 31 of the Office Action cites col. 17, l. 51 – col. 18, l. 23 of <u>Simonoff</u> asserting that

the reference "teaches a Group Web Surfing and Web Navigation function for permitting

users to view any document opened by another user <u>using the "Open File" command from the</u>

<u>White Board client's pull down menu</u>". (emphasis added)

The Group Web Surfing and Web Navigation functions in <u>Simonoff</u> require a user

input to request that the opened document be transmitted to a user participating in the

whiteboard session. This is in clear contrast to amended independent Claim 18, which recites

that the acquired content is transmitted to *all* of the *other* plurality of information processing

apparatuses currently in the chat room *"without receiving a request for the content from any*

of the other plurality of information processing apparatuses currently in the chat room."

More specifically, <u>Simonoff</u> describes that the "Sync" function (i.e. "Group Web

Surfing and Web Navigation") is accessed through a Surf selection box, which triggers the

launch of a browser when another user clicks on a Hyperlink button placed on the

whiteboard. <u>Simonoff</u> further describes that the Surf selection box "is NOT checked by

default" and that "setting the Surf control to active ... permits one user to view any document

opened by another using the 'Open File' command from the White Board client's pull down

menu."

Therefore, in the scenario of accessing a specific Hyperlink clicked by another user

when the "Surf selection box" is selected by a user, col. 17, ll. 56-66 of <u>Simonoff</u> describes

that the client automatically launches a web browser and navigates to the URL corresponding

to the Hyperlink. The process of navigating to the URL corresponding to the hyperlink is

clearly a request for content transmitted from the client device. Similarly, the scenario of

viewing a document opened by another user requires a user to select the "Open File"

command, which clearly constitutes a direct request for the document.

<u>Simonoff</u>, therefore, fails to teach or suggest that the content acquired based on a

request from one of the plurality of information processing apparatuses is transmitted to *all* of

the *other* plurality of information processing apparatuses currently in the chat room *"without*

receiving a request for the content from any of the other plurality of information

processing apparatuses currently in the chat room", as recited in independent Claim 18.
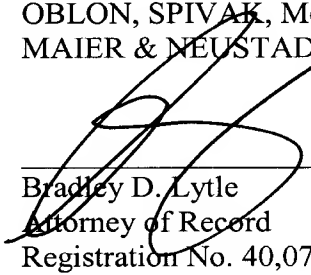
Further, none of <u>Morris</u>, <u>Johnson</u> or <u>Erdelyi</u> remedy the above noted deficiencies of

<u>Simonoff</u>.

Accordingly, for at least the reasons discussed above, Applicant respectfully requests

that the rejection of Claim 18 under 35 U.S.C. 102(e) be withdrawn. For substantially similar

reasons, it is also submitted that independent Claims 11, 4-5 and 12 (and the claims that

depend therefrom) patentably define over the applied references.

Consequently, in view of the present amendment and in light of the foregoing

comments, it is respectfully submitted that the invention defined by Claims 1-2, 4-13 and 15-

18 is patentably distinguishing over the applied references. The present application is

therefore believed to be in condition for allowance and an early and favorable reconsideration

of the application is therefore requested.

Respectfully submitted,

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